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EXAMINER

LU, KUEN S

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/864,038

Applicant(s)

ZEE, CHRISTOPHER

Examiner

Kuen S Lu

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,9-13 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,9-13 and 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendments*

1. The Action is responsive to the Applicants' Amendments, filed on February 22, 2005.
2. In responding to Applicant's Amendments made to claims 13 and 30, filed on February 22, 2005, to overcome the second paragraph of 35 U.S.C. 112, has been accepted by the Examiner and the second paragraph of 35 U.S.C. 112 rejections to claims 13 and 30 are hereby withdrawn.
3. In responding to Applicants' Amendments made to the claims 3, 13 and 30, filed on February 22, 2005, the Examiner has created this Office Action for Final Rejection as shown next. Please note, in the Office Action for Final Rejection, the Examiner maintained the same grounds as set forth in the Office Action for Final Rejection, dated January 23, 2004, for rejection claims 3, 2, 9-13 and 19-32. As for the Applicant's Remarks on claim rejections, please see discussion in the section ***Response to Arguments***, following the Office Action for Final Rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made:

5. Claims 3, 2, 10-13, 19-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (U.S. Patent 6,157,947, hereafter "Watanabe") and further in view of Wilkinson (U.S. Pub. 2001/0034695 A1).

As per Claim 3, Watanabe teaches “providing an information storage and retrieval archival system containing plural archived intellectual property (IP)” at Fig. 15 and col. 15, lines 24-39 by teaching an IP distribution system for storage and catalog of IPs.

Watanabe does not specifically teach user fee or endowment fund, although Watanabe system is a user based system where services on distribution, sharing and usage for IP is provided to users (Please see the Abstract):

However, Wilkinson teaches “enabling a user fee based access to the archived” intellectual property “in the information storage and retrieval system by users through an electronic communications network” at Page 3, [0023], [0025] and Page 4, [0035] by business entity, such as trust, foundation and endowment, to hold the intellectual property and to enforce a set of rules for regulating the market and the people qualified to conduct business on the exchange, and may assess fees or taxes, such as transaction fees or listing fees, to fund the regulatory process.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Wilkinson's teaching with Watanabe's by establishing the user fee system in the IP access, storage and retrieval archival system because by doing so there would have been a central marketplace for IP such that the users could have shared the cost for maintaining and archiving the IP database and guaranteeing its continual growth for more users to access and share.

The combined teaching of Wilkinson and Watanabe further teaches “funding an endowment trust from archival fees, said endowment trust being managed separately

from the user fee based access to provide enduring funding for the maintenance and operation of the storage and retrieval archival system to assure continued availability of the archived" intellectual property "regardless of user fee based access thereto" at Page 3, [0023] and [0025], and Page 4, [0035] of Wilkinson reference where IP listing or transaction fee may be assessed and a business entity for any purpose may hold the IP and take into account the tangible market value of IP assets, and business entity may be any business organization or part thereof, such as a partnership, fund, corporation, trust, foundation, endowment, sole proprietorship, association, and the like while Watanabe teaches a user based IP system as previously described.

As per Claim 2, Watanabe teaches "receiving instructions for the accessing and amendment of the archived IP from the users" at Fig. 26, step 302 for IP registration and step 303 for IP deletion and update; and "saving the received Instructions for accessing and amendment of the archived IP" and "indexing the saved received instructions to the archived IP and to a set of user defined key words, linkages and attributes of, and related to, the received instructions and the archived IP" at Figures 7B, 8A-8C and col. 6, lines 55-67 by using screen menus for entering, saving and performing instructions for registering, retrieving, updating and deleting IPs where keywords are entered in the specific fields and IP information indexed in the fields.

As per Claim 10, Watanabe teaches "the indexing step comprises assembling information taken from an aspects list of: intellectual property type, country of publication, author name, assignee, revenue sharing ratio, bank account, keywords, abstract, excerpts, ISBN number, ISSN number, publication date, volume number, issue number, page number, file format, file size, language rating, and violence rating" at Figure 7B by registering IP including IP name, Large, medium and small categories, disclosure extent, corresponding technology, etc.

As per Claim 11, Watanabe teaches "access step comprises at least one of the further steps of: reviewing a list of archived IP retrieved, selecting specific intellectual property to access, selecting a level of access, paying an access fee, and receiving the selected intellectual property" at Figures 8B-8C and col. 6, lines 60-67 by using retrieval and display menus for logging in, retrieving and displaying the retrieved IP information.

As per Claim 12, Watanabe teaches "receiving instructions for access step includes at least one of the further steps of: determining if the user is a member, signing the user as member, accepting agreement, paying membership fee, downloading access software, receiving open credit balance, reviewing fee schedule, selecting level of access, and paying further search and retrieval fees" at Figure 7B and col. 6, lines 55-67 by using login process to use the system which implies selecting the level of access.

As per Claim 13, Watanabe teaches the following:

“determining if the user has been granted permission, by the owner of the archived IP, to access to the selected IP; and verifying the identity of the user using at least one of user id, password, computer id, CPU id, secondary password, smart, cards, encoded Credit and biometric identification systems” at Figure 7B and col. 6, lines 55-67 by using login process which require the use of user id and password.

As for Claim 19, Watanabe teaches “establishing a Permanent IP Identification Address (PIPA) for identifying the address of the archived IP in a Permanent IP Domain (PIPD)” at Figure 7B and col. 6, lines 55-67 by using the large category as the domain of IP while IP number is the permanent identification address.

As for Claim 20, Watanabe teaches “managing the PIPD by operator-managers” at Fig. 14 and col. 14, lines 50-65 by managing the IPs based on their categories.

Watanabe does not specifically teach “separately managing the endowment trust from the management of the PIPD”.

However, Wilkinson teaches charging user listing or transaction fees for establishing the endowment trust fund at Page 3, [0023] and [0025], and Page 4, [0035], as previously described in claim 3 rejection.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Wilkinson's teaching with Watanabe's by establishing endowment trust fund collecting from IP registration and use and placing its management separately from the management of IP storage and archival, since the

management of fund is financial in nature while IP management deals with intellectual property.

As per Claim 21, Wilkinson further teaches assessing an archival fee associated with archived IP at Page 3, [0024]-[0025] by evaluating the value of the IP assets and charging user with listing and transaction fee.

As for Claim 22, Wilkinson further teaches augmenting the database management fund with the archived IP with donations, grants or operating surplus at Page 3, [0025] where endowment trust fund may be established by donations.

As per Claim 23, Wilkinson teaches pooling endowment funds for a plurality of archived IP for further enhancing the permanence of the fund at Page 3, [0025] by including the use as a basis for any financial transaction or for any business or financial purpose, including, for taxation, preparation of financial statements, debt/equity transactions, purchases, sales, loans, collateral, donations, exchanges, investing, trading, mergers, acquisitions, spin-offs, liquidation, buybacks, leveraged buyouts, stock/debt exchanges, hedge funds, and the like.

As per Claim 24, Watanabe teaches each IP record containing large category as the domain and IP number as the identification at Fig. 7B and col. 7, lines 55-67, "establishing one or more access files separate from the archived" at Fig. 7B and col. 6,



lines 55-67 by exporting the registered IP to a local file, and “each access file associated with a user” and “enabling access to an access file by a user wherein each access file comprises the PIPA for the archived IP, an identity of the user, and value-added information by the user” at Figures 6-7B and col. 6, lines 39-49 and 55-59 by registering PIPA (IP number) for the archived IP, username and valued-added information.

As per Claim 25, Watanabe teaches “accessing a users access file by the accessing user” at Fig. 7B and col. 6, lines 55-67 by importing a local file to display the registered IP, “combining the value-added information and the archived IP into a combined product” and “presenting the combined product to the accessing user” at col. 6, lines 39-49 and 55-59 by registering PIPA (IP number) for the archived IP, username and valued-added information and presenting the combined product by the accessing user at Fig. 7B and col. 6, lines 55-67 by displaying the registered IP.

As per Claim 26, Watanabe teaches “accessing a first users first access file by a second user for forming a second access file” at Fig. 7B and col. 6, lines 55-67 by importing a local file created through exporting an archived IP by a first users; “combining value-added information of the first and second access files and the archived IP of the into a combined product; and presenting the combined product to the second accessing user” at Figure 7B by combining the value-added information through

registering IP data, including IP name, Large, medium and small categories, disclosure extent, corresponding technology, etc.

As per Claim 27, Watanabe teaches "opening an access file and obtaining a presentation of the combined product including at least the PIPA for the archived IP and the permanently archived IP associated therewith" at Fig. 7B, col. 6, lines 55-67 by importing a local file for an archived IP whose value-added information was combined by local file exporting, registration and importing processes.

As per Claim 28, Watanabe teaches "initiating the creation of an access file by a user by the entry of information associated with the archived IP; and once the archived IP is identified, the PIPA for the archived IP, an identity of the user, and value-added information by the user can be added to the access file" at Fig. 7B, col. 6, lines 55-67 by importing a local file of an archived IP, updating the menu with the IP number, username and value-added information, and saving and/or exporting the updated.

As per Claim 29, Watanabe teaches "searching a plurality of access files to ascertain if archived IP is stored for retrieval, and if so opening the access filed associated with the archived IP for obtaining a presentation of the combined product including at least the PIPA for the archived IP and the permanently archived IP associated therewith" at Fig. 7B and col. 6, lines 55-67 by importing local file corresponding with the archived IP through local file name.

As per Claim 31, Watanabe teaches exporting archived into a local file at Fig. 7B and col. 6, lines 55-67.

Watanabe does not specifically teach “step of establishing an index tag for each archived IP and comprising at least a PIPA for the archived IP, the index tags being useful for indexing purposes”.

However, Wilkinson teaches (Page 4, [0035]) constructing (gathering data and computing) an IP index or indices composed of individual IP assets, IP-impacted securities, or entities holding IP assets for the purpose of investment, comparison, and performance evaluation purposes. In this way, financial instruments related to IP assets or entities holding IP assets may be tracked against the performance of other IP assets or entities holding IP assets.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Wilkinson's teaching with Watanabe's by indexing archived IP information such that the index would have been used as a basis to compare investments, select investments, or a combination thereof, and further tracking the performance of the archived IP.

As per Claim 32, Watanabe teaches “backing up the access file on the storage and retrieval archival system operated in the PIPD” at Fig. 7B and col. 55-67 by exporting the same archived IP to local files placing at different drives or backup media.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (U.S. Patent 6,157,947, hereafter "Watanabe") and in view of Wilkinson (U.S. Pub. 2001/0034695 A1), as applied to Claims 3 and 2 above, and further in view of Couchman (Oracle DBA Certification Exam Guide, Oracle Press, 1998) and Baba et al. (U.S. Patent 5,758,057).

As per claim 9, the combined Watanabe-Wilkinson teaches IP archived and storage system by networking database servers and client systems.

Neither Watanabe nor Wilkinson teaches system backup, mirroring, disaster recovery or multi-media equipments settings.

However, Baba teaches mirror system configuration at Fig. 1, elements 011a and 100b, col. 8, lines 23-24, and multi-media storage configuration and user connections at Fig. 5, col. 9, lines 21-25.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Wilkinson and Baba's references into Watanabe's system by specifically mirroring disk drives so that all archived IPs would have an on-line and redundant backup to ensure any storage failure could be repaired while the information archiving and retrieving system maintained operational.

The combined Watanabe-Wilkinson-Baba reference teaches IP storage and archived system equipped with mirror disk drives.

Neither Watanabe, Wilkinson nor Baba teaches disaster recovery for the IP archiving and retrieving system.

However, Couchman teaches physical disaster recovery system at Chapters 13-15.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Couchman, Wilkinson and Baba's references with Watanabe's by implementing a disaster recovery system which must be remotely located such that the Watanabe's IP archiving and retrieving system would be fully reliable during the events of system fault or natural disaster because of redundant copies, different principles of practice and remotely storage of backups.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (U.S. Patent 6,157,947, hereafter "Watanabe") and in view of Wilkinson (U.S. Pub. 2001/0034695 A1), as applied to Claims 3, 2 and 19 above, and further in view of Couchman (Oracle DBA Certification Exam Guide, Oracle Press, 1998).

As per Claim 30, the combined Wilkinson and Watanabe reference teaches IP distribution, usage and sharing is a user based system where IP information includes at least one of name, username, number, address, large category, etc. as previously described in claims 2, 3, 19 and other dependent claims rejections.

Watanabe does not specifically teach "as only IP selected by owners are archived in the PIPD".

However, Couchman teaches granting privileges of selecting specific information to specific user(s) at Page 189 by examples of SQL GRANT statements.

It would have been obvious to one having ordinary skill in the art at the time of the

applicant's invention was made to combine Couchman's teaching with the Wilkinson and Watanabe references by implementing more specific control of selecting IP, via information technology for implementing the IP distribution system, to storage and retrieval archival system because by doing so there would have been a better selected archive of IP because IP owners are the groups of persons know IP best.

The combined teaching of Wilkinson and Watanabe further teaches "IP owners fund an endowment fund for the archived IP" at Page 3, [0023] and [0025], and Page 4, [0035] of Wilkinson reference wherein IP listing or transaction fee may be assessed and a business entity for any purpose may hold the IP and take into account the tangible market value of IP assets, and business entity may be any business organization or part thereof, such as a partnership, fund, corporation, trust, foundation, endowment, sole proprietorship, association, and the like further suggests flexibility of business practice for funding process executing by the owners of funding properties.

The further combined teachings of Wilkinson, Watanabe and Couchman further teaches "only IP selected and funded by IP owners are archived in the PIPD" (See Wilkinson: Page 3, [0023] and [0025], and Page 4, [0035] of Wilkinson reference wherein IP listing or transaction fee may be assessed and a business entity for any purpose may hold the IP and take into account the tangible market value of IP assets, and business entity may be any business organization or part thereof, such as a partnership, fund, corporation, trust, foundation, endowment, sole proprietorship, association, and the like further suggests flexibility of business practice for funding process executing by the owners of funding properties, and Couchman: Page 189

wherein granting privileges of selecting specific information to specific user(s) by examples of SQL GRANT statements).

### ***Response to Arguments***

8. The Applicant's arguments filed on February 22, 2005, have been considered but they are not persuasive, please see discussion below:

a). At Pages 9-12, the Applicant argued mainly that both Watanabe and Wilkinson systems are not user fee based.

As to the above argument, the Examiner respectfully disagreed. First of all, Watanabe is a system for registering, distributing and sharing IP among users and providing IP related services to users, as clearly described in the Abstract. It would be fair to claim that Watanabe is a user based system for allowing users to share and access IP. Secondly, across the Office Action, Wilkinson reference is cited for teaching IP as an asset in a market accessible to owner and others through common business practices and Wilkinson system provides a centralized platform and business entity for users to conduct transactions, and pay transaction fess wherein the business entity may be in the form of partnership, fund, corporation, trust, foundation, endowment, sole proprietorship, or association. Based on the above descriptions, the Examiner fairly interpreted as a user based system, much more importantly, a user fee based system for assessing and accessing IP. The Examiner would like to point out that endowment and/or trust are clearly included in the business practice.

In order to provide suggestion or motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, referring to Watanabe's teaching on providing IP usage, distribution, sharing and services to users, and further referring to Wilkinson's teaching of fee based practice under flexible and diversified business entity and platform for providing IP marketing services to owners and others, the Examiner comes to the conclusion that it would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Wilkinson's teaching with Watanabe's by establishing the user fee system in the IP access, storage and retrieval archival system because by doing so there would have been a central marketplace for IP such that the users could have shared the cost for maintaining and archiving the IP database and guaranteeing its continual growth for more users to access and share.

b). At Pages 13-14, concerning claims 19-32, the Applicant continued to argue the differences of teachings provided between the references and the Application. For example, the Applicant argued that the Application archives each IP by a unique PIPA code and attached index tag.



As to the above argument, the Examiner respectfully disagreed. Please note the Examiner examines invention based on claims, in light of the specification of the Application. The Watanabe reference teaches registering IP wherein the teaching may not be as descriptive to the details of stating that each IP is registered with a unique ID. However, it is well known to an ordinary skilled in the art that IP is uniquely identified and registered, for example, USPTO issues each patent with a unique patent number.

9. In light of the forgoing arguments, the 35 U.S.C 103 rejection for Claims 3, 2, 9-13 and 19-32 is hereby sustained.

10. The prior art made of record

A. U.S. Publication 2001/0034695 A1

B. U.S. Patent 5,758,057

U. Oracle DBA Certification Exam Guide, J. Couchman, Oracle® Press, 1998

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

C. U.S. Patent 6,157,947

### **Conclusions**

11. **THIS ACTION IS MADE FINAL.**

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is 571-272-3574 for faster service.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 571-272-4114.

The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

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Kuen S. Lu

  
Patent Examiner

April 21, 2005

  
Luke Wassum

Primary Examiner

April 21, 2005